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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/894,108	06/28/2001	Dwip N. Banerjee	AUS920010309US1	6271
45440	7590	01/27/2006	EXAMINER	
IBM CORPORATION (SS) C/O STREETS & STEELE 13831 NORTHWEST FREEWAY, SUITE 355 HOUSTON, TX 77040			DENNISON, JERRY B	
			ART UNIT	PAPER NUMBER
			2143	

DATE MAILED: 01/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	09/894,108	BANERJEE ET AL.	
	Examiner	Art Unit	
	J. Bret Dennison	2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Action is in response to Application Number 09/894,108 received on 04 October 2005.
2. Claims 1-7, and 8-48 are presented for examination.
3. The prosecution for this Case has been transferred to another Examiner.

Response to Arguments

Applicant's arguments with respect to claims 1-47 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments include the failure of previously applied art to disclose, "that *after* expiration of the subscription period, access to the subscription is *not terminated* but just provided at a level of service *that is lower than* the pre-expiration level of service" [see Applicant's Response, page 12, paragraph 4].

As shown in the present rejection Drosset disclosed a method and system for a subscriber based service over a communication network in which users are set up with a payment schedule by credit card (Drosset, col. 15, lines 19-20), where the website submits a request to debit the account by the schedule chosen (Drosset, col. 15, lines 27-29) and the account may be downgraded to nonpaying membership through invalidation of the payment information i.e. expired or invalid credit card (Drosset, col. 15, lines 47-51) and the user is denied the privileges afforded to paying users (Drosset, col. 15, lines 51-52).

In other words, the teachings of Drosset allow a set schedule for payment by credit card, and if such instances occur at the time payment is due (i.e. expired or

invalid credit card) the payment date has expired and the membership is downgraded to a non-paying membership. The account is not terminated, but rather just downgraded until the customer has made payment.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3-5, 13-15, 36, 37, and 44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "gradually" in claims 3-5, 13-15, 36, 37, and 44 is a relative term which renders the claim indefinite. The term "gradually" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Examiner was unable to locate a definition for the term "gradually" in the instant specification. The term as it appears in claim 3, is further limited in claim 4, meaning "incrementally". Examiner will use this definition for all claims that recite the term.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3, 4, 33, and 48 are rejected under 35 U.S.C. 102(e) as being anticipated by Drosset et al. (U.S. 6,662,231).

4. Drosset disclosed a method and system for a subscriber based service over a communication network in which users are set up with a payment schedule by credit card (Drosset, col. 15, lines 19-20), where the website submits a request to debit the account by the schedule chosen (Drosset, col. 15, lines 27-29) and the account may be downgraded to nonpaying membership through invalidation of the payment information i.e. expired or invalid credit card (Drosset, col. 15, lines 47-51) and the user is denied the privileges afforded to paying users (Drosset, col. 15, lines 51-52).

Therefore, regarding claims 1, 33, and 48, Drosset disclosed a method to be executed by one or more processors for managing subscriber access to online subscription content comprising:

(a) providing the subscriber with access to the online subscription service at a first level of service during a subscription period (Drosset, col. 15, line 14, Drosset disclosed a user provided with a paying membership).

(b) after expiration of the subscription period, providing the subscriber with access to the online subscription service at a level of service that is lower than the first level of service without terminating the access (Drosset, col. 15, lines 21-23, 45-65, Drosset disclosed that if payment is not received on the **scheduled payment date** then the users membership is downgraded to a non-paying membership).

Claims 33 and 48 include a computer program product with limitations that are substantially similar to those of claim 1.

Therefore claims 29, 33, and 48 are rejected under the same rationale as claim 1 as being substantially similar.

5. Regarding claim 2, Drosset disclosed the limitations substantially as claimed, as described in claim 1, including wherein the level of service is determined by a service parameter selected from download rate, portion of subscription content accessible, access to member-only features, color formatting, sound and combinations thereof (Drosset, col. 15, lines 47-65).

6. Regarding claims 3-5, Drosset disclosed the limitations, substantially as claimed, as described in claim 2, including gradually reducing the level of service during the post-expiration period (Drosset, col. 15, lines 45-55, Drosset disclosed incrementally reducing the level of service once), and notifying the user of any problems existing with their account (Drosset, col. 15, lines 29-58).

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7. Regarding claim 6, Drosset disclosed the limitations, substantially as claimed, as described in claim 1, including allowing customers to renew their subscription at the paying membership level (Drosset, col. 15, lines 40-67).

8. Regarding claim 7, Drosset disclosed the limitations, substantially as claimed, as described in claim 6. Claim 7 is a reiteration of steps performed in claims 1 and 6, and is therefore rejected under the same rationale.

9. Regarding claim 9, Drosset disclosed the limitations, substantially as claimed, as described in claim 1, including notifying the customer of problems that need to be fixed for subscription renewal (Drosset, col. 15, lines 29-35).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Drosset.

10. Regarding claim 10, Drosset disclosed the limitations, substantially as claimed, as described in claim 1. Drosset did not explicitly state terminating subscriber access to the online subscription service after a specified post expiration period. Examiner takes Official Notice (see MPEP § 2144.03) that terminating a subscription service after an expiration date in a subscription providing system was well known in the art at the time the invention was made. The Applicant is entitled to traverse any/all official notice taken in this action according to MPEP § 2144.03, namely, "if applicant traverses such an assertion, the examiner should cite a reference in support of his or her position". However, MPEP § 2144.03 further states "See also *In re Boon*, 439 F.2d 724, 169 USPQ 231 (CCPA 1971) (a challenge to the taking of judicial notice must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the judicial notice)." Specifically, *In re Boon*, 169 USPQ 231, 234 states "as we held in *Ahlert*, an applicant must be given the opportunity to challenge either the correctness of the fact asserted or the notoriety or repute of the reference cited in support of the assertion. We did not mean to imply by this statement that a bald challenge, with nothing more, would be all that was needed". Further note that 37 CFR § 1.671(c)(3) states "Judicial notice means official notice". Thus, a traversal by the Applicant that is merely "a bald challenge, with nothing more" will be given very little weight. See *Nye* (U.S. 2003/0028548), page 4, ¶ 48.

Claims 11, 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Drosset in view of *Nye* (U.S. 2003/0028548).

11. Regarding claim 11, Drosset disclosed the limitations, substantially as claimed, as described in claim 1. Drosset did not explicitly state wherein the subscriber is a potential new subscriber and wherein the subscription period is a trial subscription period.

However, in the same field of endeavor, Nye disclosed, in a subscription environment, various states of customer subscriptions, including free trial subscriptions (Nye, ¶ 46).

Thus it would have been obvious to one of ordinary skill in the art at the time of the invention was made to include Nye's teaching of various states of customers' subscriptions with Drosset to not only provide specific promotions and offers (Nye, ¶ 44), but also to efficiently be able to determine the customer's state transitions from one state to another (Nye, ¶ 45).

Regarding claims 13-15, Drosset and Nye disclosed the limitations substantially as claimed as described in claims 1 and 11, and are therefore rejected under the same rationale.

12. Regarding claim 12, Drosset and Nye disclosed the limitations substantially as claimed, as described in claim 11, including wherein the level of service is determined by a service parameter selected from download rate, portion of subscription content

accessible, access to member-only features, color formatting, sound and combinations thereof (Drosset, col. 15, lines 47-65).

Claims 21, 29, and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Drosset in view of Davis et al. (U.S. Pub. 2002/0040395).

13. Regarding claims 21, 29, and 46 Drosset disclosed a system with limitations that are substantially similar to those of claim 1, further including managing a subscriber's account through the use of a subscription service, subscription database, and a non-renewal database (Drosset, col. 2, lines 40-45).

Drosset did not explicitly disclose that the database contains post expiration access frequency.

However, in the same field of endeavor, Davis teaches a system for online subscription service (Davis, ¶ 32), which includes a database for recording client's activities, including frequency of accessing data from online provider (Davis, ¶ 9). Thus it would have been obvious to one of ordinary skill in the art at the time of the invention was made to include Davis 's idea of tracking user's frequency of accessing online provider and commercialize targeting the particular user with Drosset for determining users' behavior after subscription period has expired. Because in doing so, the system of Drosset would be able to accurately predict whether the particular subscribers would be interested in or could be induced to renew subscription.

14. Regarding claim 22, Drosset and Davis disclosed the limitations substantially as claimed, as described in claim 21, including wherein the level of service is determined by a service parameter selected from download rate, portion of subscription content accessible, access to member-only features, color formatting, sound and combinations thereof (Drosset, col. 15, lines 47-65).

Claims 16-20, 23, 24-28, 30-32, 34-45, and 47 include limitations substantially similar to the limitations of claims 1-15, 21, 22, 29, 33, 46, and 48, and are therefore rejected under the same rationale as being substantially similar.

Conclusion

Examiner's Note: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant.

Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure

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relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Bret Dennison whose telephone number is (571) 272-3910. The examiner can normally be reached on M-F 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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